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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,494	08/29/2006	Kazuo Tagawa	07481.0045	5119
22852	7590	03/12/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VASISTH, VISHAL V	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			03/12/2010 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,494

Applicant(s)

TAGAWA ET AL.

Examiner

VISHAL VASISTH

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 2/25/2010 has been entered.

Response to Amendment

2. Applicants' response filed on 2/25/2010 amended independent claims 10, 13 and 16. Applicants' amendments overcome the 35 USC 102 rejection over Seiki and the 35 USC 103 rejections over Seiki in view of Kawahara, and Seiki in view of Shimomura. Therefore, these rejection have been withdrawn. Applicants did not file a terminal disclaimer to obviate the double patenting rejection from the office action mailed on 12/15/2008 therefore this rejection is maintained below and incorporated herein by reference. A new ground of rejection necessitated by the amendment is set forth below.

Claim Objections

3. Claims 10 and 13 are objected to because of the following informalities: claim 10 currently recites, "at least one selected from phosphorus additives and epoxy compounds," wherein claim 10 should read, "at least one [compound or additive]

selected from phosphorus additives and epoxy compounds." Appropriate correction is required.

Claim 13 currently recites, "(A5) hydrocarbyl ether of (A1)-(A4)," wherein claim 13 should read, "(A5) hydrocarbyl ether of (A1), (A2) or (A4)." Appropriate correction is required.

Claim Rejections - 35 USC § 102

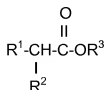
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawahara et al., US Patent No. 6,667,285 (hereinafter referred to as Kawahara). The examiner notes that this is the US national phase application (therefore in English) of WIPO application No. WO/2000/068345 which is in Japanese and has a 102(b) date.

Kawahara discloses a lubricating oil composition for refrigerators comprising at least one aliphatic saturated branched-chain carboxylic acid monoalkyl ester represented by the formula:



wherein when R^2 is hydrogen, R^1 is a branched-chain alkyl and R^3 is C_1 - C_{20} straight-chain alkyl (monoesters of a monobasic fatty acid having 12 or more carbon atoms and a monohydric alcohol having 1-24 carbon atoms (as recited in claim 10) (Col. 2-3/L. 64-15). Kawahara further discloses the aforementioned ester base oil used in combination with a full ester made up of reaction components including a fatty acid having 3 to 18 carbon atoms and a C_2 to C_{10} aliphatic polyhydric alcohol having 2 to 6 hydroxyl groups such as neopentyl glycol (as recited in claim 10) (Col. 15-17/L. 5-61). The ester additive can be present in the composition in as little concentration as 0.05 wt% based on the concentration ratios disclosed in columns 24 and 25 of Kawahara (within the range as recited in claim 11).

The composition of Kawahara may further contain other base oils such as alicyclic dicarboxylic acid esters esterified by monohydric alcohols (Col. 14/L. 21-26 and Col. 15-16/L. 55-3) (as recited in claim 12), epoxy compounds and phosphorus-containing anti wear additives such as tricresyl phosphate (as recited in claim 10) (Col. 20-21/L. 47-55).

Claim Rejections - 35 USC § 102

6. Claims 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Corr et al., US Patent Application Publication No. 2002/0013233 (hereinafter referred to as Corr).

Corr discloses a refrigeration lubricant composition comprising alkyl benzenes (predetermined base oil of claims 13 and 16) (Para. [0036]) in combination with

polyalkylene glycols. The polyalkylene glycols of Corr include hydroxyl group initiated polyoxyalkylene glycols, for example ethylene and/or propylene oxide oligomers initiated on polyhydric alcohols, for example, pentaerythritol and glycerol ((A1) of claims 13 and 16) (Para. [0063]). The fully formulated refrigeration composition of Corr further includes additives such as dithiophosphates (phosphorus additive of claims 14 and 17) (Para. [0077]) and triaryl phosphorothionates (phosphorothionates of claims 15 and 18) (Para. [0079]).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 10-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending

Application No. 10/565,739. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The rejection from paragraph 11 of the office action mailed on 12/15/2008 is incorporated herein by reference.

Response to Arguments

9. Applicants' arguments filed on 9/17/2009 with respect to claims 10-18 have been fully considered and are moot in light of the new grounds of rejection set forth above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Yokota et al., US Patent No. 7,595,286 (hereinafter referred to as Yokota).

Yokota discloses a lubricant composition comprising a full ester of polyol and a fatty acid.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797